

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MIGAKU SUZUKI

Appeal No. 2000-0287
Application No. 08/663,300

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS and JENNIFER D. BAHR, Administrative Patent Judges.

JENNIFER D. BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-19, which are all of the claims pending in this application. An amendment to claims 1, 13, 16, 17 and 19 and a substitute specification (Paper No. 16), filed February 5, 1999 subsequent to the final rejection, have both been entered (see Paper No. 17 and page 2 of the answer). The amendment after final rejection to claims 13 and 17 filed concurrently with the brief (Paper No. 20) and again with the reply brief (see Paper Nos. 24 and 26) and the amendment (Paper No. 27) to the specification filed concurrently with the reply brief have not been entered (see Paper No. 28). We additionally note that the appellant's substitute specification filed February 20,

1998 (Paper No. 10) was not entered. Any future references to "the substitute specification" in this decision will refer to the February 5, 1999 substitute specification which has been entered.

BACKGROUND

The appellant's invention relates to a stretch activated elastic composite (claims 1-16 and 19) and a disposable absorbent garment comprising such a composite (claims 17 and 18). An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.¹

The following rejections stand before us for review.

(1) Claims 1-19 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

(2) Claims 13-15, 17 and 18 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

¹ The copies of claims 13 and 17 appearing in the appendix to the appellant's brief are inaccurate reproductions of the claims of record, in that they incorporate the amendments thereto (claim 13, line 9; claim 17, line 16) which have not been entered by the examiner. These claims (claim 13, line 9; claim 17, line 16) actually read "a stress of lower than 100 g [not 1000 g] at 30% stretch."

reasonably convey to one skilled in the relevant art that the appellant, at the time the application was filed, had possession of the claimed invention.²

(3) Claims 11, 14 and 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Reference is made to the brief and reply brief (Paper Nos. 20 and 24) and the answer (Paper No. 21) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Rejection (1)

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the appellant's application, would have enabled a person of such skill to make and use the appellant's invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232,

² The examiner has withdrawn this rejection as to claims 1-12, 16 and 19 in light of the amendment filed February 5, 1999 (see Paper No. 17).

212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellant's disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

The examiner contends that one of ordinary skill in the art would not be able to make and use the appellant's claimed invention because the appellant's claims define properties of elements of the claims without corresponding recitation of the standards used to measure those properties and because even the appellant's disclosure does not identify the particular JIS standards used for such measurement tests (answer, page 5). For the reasons which follow, we conclude that the examiner's rejection of the claims on this basis is not well founded.

Initially, we note that it is the function of the specification, not the claims, to set forth the "practical limits of operation" of an invention. One does not look to claims to find out how to practice the invention they define, but to the specification. See In re Johnson, 558 F.2d 1008, 1017, 194 USPQ 187, 195 (CCPA 1977).

As pointed out by the appellant (brief, pages 10-11), the appellant's specification (substitute specification, pages 8-9; original specification, pages 5-6) describes the major points or parameters of the measurements. From our perspective, the details provided in the appellant's specification appear to be sufficient to have adequately informed one of ordinary skill in the art at the time the application was filed of the process for carrying out the required measurements of the recited properties or, if necessary, to have directed such a person to the proper Japanese Industrial Standard for additional

details and the examiner has not advanced any explanation as to why this would not have been the case.

Turning to the examiner's second basis for rejecting the claims for lack of enablement, the examiner asserts that the claims are broader than the disclosure in the application and that, consequently, one of ordinary skill in the art would not have been able to make and use the full scope of the claimed invention from the appellant's disclosure, even if coupled with additional information known in the art. In particular, the examiner asserts that none of the claims is limited to "the [non-woven fabric] sheet having to have potential elongation higher than 100% in a biased direction in combination with the other features" (answer, page 4).³ The examiner's concern appears to be rooted in the distinction between the claim language "in one direction" (claims 1, 16 and 19, lines 2-3) and "in said one direction" (claim 13, line 9; claim 17, line 16) and the disclosure in the specification (the substitute specification, page 3, lines 1-3; original specification, page 2, lines 3-5) that the non-woven fabric has "a potential elongatability of higher than 100% in a biased direction" (our emphasis).

We do not agree with the examiner that, in this instance, the claim language "in one direction" in claims 1, 16 and 19 or "in said one direction" in claims 13 and 17 is broader than the terminology "in a biased direction" used in the specification. In particular, we conclude

³ While the examiner's first rejection (Paper No. 6, pages 2 and 3) referred to additional examples of the originally filed claims being broader in scope than the underlying disclosure, these earlier-cited examples are presumed not to be applicable to the claims before us on appeal, as the examiner's answer has not repeated them.

from our reading of the appellant's specification as a whole that "a biased direction" means nothing more than the direction in which the non-woven fabric sheet is elongatable (adapted to be elongated).⁴ Therefore, the omission of the adjective "biased" to describe that direction does not render the limitation "adapted to be elongated by more than 100% in one direction" in claims 1, 16 and 19 more broad than the language at issue in the specification. As for claims 13 and 17, while the terminology "in said one direction" lacks clear antecedent basis in the claims, we are of the opinion that one of ordinary skill in the art reading the claim as a whole would understand that the elastic composite would be stretched in a direction in which both the non-woven fabric sheet and the elastic sheet are elongatable or stretchable and that "said one direction" thus refers to such direction.⁵ Consequently, for the same reasons discussed above with regard to claims 1, 16 and 19, we consider the omission of the term "biased" from claims 13 and 17 to be inconsequential to the scope of the claims. In any event, the examiner has not advanced any reasoning in support of the contention that the appellant's disclosure is insufficient to have enabled one of ordinary skill in the art to make and use the invention recited in these claims without undue experimentation.

⁴ We recognize that "biased" is frequently used in the textiles field to denote a direction inclined at an angle with respect to both the machine direction and cross direction of the fabric, in addition to its other usage to denote elongatability. However, in this instance, given the appellant's disclosure (the substitute specification, page 12; original specification, page 7) that the most suitable known non-woven fabric for use in the present invention preferably has high elongatability in the machine direction (MD) or in the cross-direction (CD), the term "biased" does not appear to be used in the context of an angle inclined with respect to both the MD and CD.

⁵ While we do not consider this lack of antecedent basis to be of such a nature as to render the scope of the claims indefinite, it is deserving of correction in the event of further prosecution before the examiner.

For the foregoing reasons, we shall not sustain the examiner's rejection of independent claims 1, 13, 16, 17 and 19, or claims 2-12, 14 and 15 and 18 which depend from claims 1, 13 and 17, respectively, under the first paragraph of 35 U.S.C. § 112, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Rejection (2)

The examiner has rejected claims 13-15, 17 and 18 under the first paragraph of 35 U.S.C. § 112 on the basis that the limitation "a stress of lower than 100 g at 30% stretch" (claim 13, line 9; claim 17, line 16)⁶ is not supported in the specification as originally filed. We initially observe that the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978). With respect to the description requirement, the court in Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563-64, 19 USPQ2d at 1117 stated:

35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was

⁶ These stress value limitations were added to claims 13 and 17 in the amendment filed February 20, 1998 (Paper No. 9).

in possession ***of the invention***. The invention is, for purposes of the "written description" inquiry, ***whatever is now claimed***.

In this instance, the appellant's specification as originally filed discloses that the stress at 30% for the initial stretch is lower than 1000 g (page 2, line 8; original claims 1 and 19) and that a desirable value is not more than 1000 g, preferably 800 g and more preferably 600 g (page 6, lines 5-6).⁷ There is no indication in the originally filed specification that the 30% stretch stress for the initial stretch be lower than 100 g.

The appellant does not argue to the contrary. Rather, the appellant's only argument with regard to this rejection is that the amendment filed May 28, 1999 with the appeal brief (and again with the reply brief) corrected "100 g" to "1000 g" in claims 13 and 17 (see reply brief, page 9). However, as this amendment has not been entered⁸ (see Paper No. 28), claims 13 and 17 still recite that the initial 30% stretch stress is lower than "100 g."

For the foregoing reasons, we are constrained to summarily sustain the examiner's rejection of independent claims 13 and 17, as well as claims 14 and 15 which depend from claim 13 and claim 18 which depends from claim 17, under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not supported by the appellant's original disclosure.

⁷ We note that original claim 16 also included a recitation that this value is "lower than" 800 g.

⁸ The examiner's stated reason for refusing entry of this amendment (that a supplemental appendix of claims incorporating the changes was not filed in triplicate) is somewhat puzzling to us, in that the copies of claims 13 and 17 contained in the appendix of claims accompanying the appellant's brief did reflect those amendments. However, as we do not exercise any supervisory authority over the examining corps, we decline to consider whether the examiner abused her discretion in this matter.

Rejection (3)

The examiner has rejected claims 11, 14 and 18 on the basis that the terminology "band-like" renders the claims indefinite. In particular, the examiner queries how the regions or portions recited in these claims are "like" a band (answer, page 6).

Initially, we note that the purpose of the second paragraph of Section 112 is to basically insure, with a **reasonable** degree of particularity, an **adequate** notification of the metes and bounds of what is being claimed. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). When viewed in light of this authority, we cannot agree with the examiner that the metes and bounds of claims 11, 14 and 18 cannot be determined because of the alleged deficiency noted by the examiner. A degree of **reasonableness** is necessary. As the court stated in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of Section 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a **reasonable** degree of precision and particularity. It is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Emphasis ours; footnote omitted.]

While it is true that the addition of the term "like" or "type" may, in some instances, render unclear the scope of an otherwise clear claim, that is not the case here. The appellant's specification describes "band-like" securement regions which extend transversely with respect

to the elongatable and stretchable direction of the non-woven fabric and elastic sheet (the substitute specification, pages 16 and 17, describing Figures 10A-10C; original specification, page 10), "band-like" areas 111 in Figure 14 and a "band-like" area 111 in Figure 15 (the substitute specification, page 20; original specification, page 12). In each of Figures 10A-10C, 14 and 15, the "band-like" regions or areas are illustrated as elongate strips extending across the material. In light of this disclosure, one of ordinary skill in the art would have understood "band-like" regions or portions as used in the claims to be regions which are elongate in shape and extend across the composite. It is in this respect that they are like bands.⁹

For the foregoing reasons, we conclude that the terminology "band-like" does not render the scope of claims 11, 14 and 18 indefinite. Accordingly, we shall not sustain the examiner's rejection of these claims under the second paragraph of 35 U.S.C. § 112.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-19 under the first paragraph of 35 U.S.C. § 112 (enablement requirement) and claims 11, 14 and 18 under the second paragraph of 35 U.S.C. § 112 is reversed. The decision of the examiner to reject claims 13-15, 17 and 18 under the first paragraph of 35 U.S.C. § 112 (description requirement) is affirmed.

⁹ A "band" is "a contrasting strip or stripe running across or along the edge of a material, or separating different sorts of material." Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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Christopher C. Campbell, Esq.
Hunton & Williams
1900 K Street, N.W.
Washington, DC 20006-1109

JDB:caw